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PATENTS

UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Weiner

Examiner: Ruddock

Serial No.: 10/678,316

Group Art Unit: 1771

Filed October 2, 2003

For: IMBEDDED VINYL FLOORING PRODUCT

**REQUEST FOR REINSTATEMENT OF THE APPEAL**

Commissioner for Patents and Trademarks  
Alexandria, Virginia 22313-1450

Sir:

The applicant has received the Office Action dated December 15, 2006 enumerating new grounds of rejections based primarily on a newly cited reference in a non-final Office Action.

A Supplemental Appeal Brief is enclosed herewith.

The Applicant respectfully requests Reinstatement of the Appeal.

Respectfully submitted,

Date: March 13, 2007

By: 

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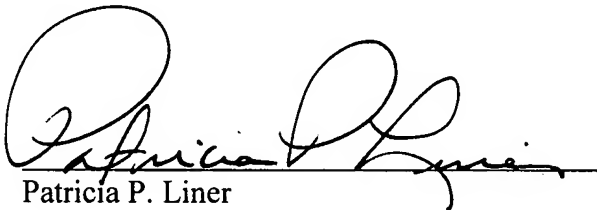


CERTIFICATE OF MAILING

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on this 13<sup>th</sup> day of March, 2007.

  
Patricia P. Liner



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**SUPPLEMENTAL APPEAL BRIEF**

Commissioner of Patents and Trademarks  
P. O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

Further to the Notice of Appeal filed June 2, 2006, and the request for reinstatement filed herewith, herewith are three copies of Appellants' Supplemental Brief on Appeal. The statutory fee of \$250 for the Notice of Appeal fee was paid on June 2, 2006. The \$250 fee for the submission of the appeal brief was enclosed with the filing made on July 14, 2006. Please charge any additional fee or credit any overpayment to Deposit Account No. 13-3403. Three copies of this page are attached for this purpose.

**I. PRESENTATION OF THE APPEAL**

**A. Real Party in Interest**

The real party in interest is Appellants' assignee, Product Concepts Residential, LLC, a Georgia limited liability company with its principal place of business at 525-B Calahan Road, Dalton, GA 30722.

**B. Related Appeals and Interferences**

There are no related appeals and interferences.

### **C. Status of Claims**

At the time of the final Office Action, claims 1-10 were pending in the application. The application was initially filed with 10 claims as a division of U.S. Patent No. 10/125,290, now U.S. Patent No. 6,696,004. The claims of this application have not been amended.

A copy of the claims subject to this appeal appears in Appendix A.

### **D. Status of Amendments**

No proposed amendments have been proposed or entered after final.

### **E. Summary of Invention**

Most generally, the present invention relates to a vinyl flooring product having a design visible from a top surface of the product, and more particularly to a vinyl flooring product having an imbedded web creating a pattern visible from above. (Page 1, lines 5-6). As shown in Figure 1, a mesh **10** has limbs or runners **32** which meet at one or more junctures **35,37** and circumscribe openings **34**. (Page 2, lines 21-22). The runners **32** have top surface **36** and bottom surfaces **37**. (Page 2, line 23 – Page 3, line 1). The mesh **26** is embedded in a presently preferred process into a liquid vinyl layer and cured. (Page 3, lines 13-15).

The depth at which the mesh **10** is imbedded in the liquid influences the design on the flooring product after curing in the oven. (Page 4, lines 3-4). In all of the embodiments, the vinyl forms a vinyl bottom layer **42** which forms a non-porous sheet surface which extends below the mesh **10**. (Page 4, lines 8-9). In a first embodiment, the bottom surface **37** of the runner is below a top surface **44** of the vinyl. (Page 4, lines 8-9). Slight wicking of the vinyl may be observed on the walls **30** of the runners **32**. (Page

4, lines 9-10). In other embodiments, the vinyl may wick up toward a top surface 36 and form bubbles 36 within the openings 34 of the mesh 10 without obscuring the top surface 36 of the mesh 10. (Page 4, lines 10-13). In yet another embodiment, the vinyl extends through the openings 35 and extends over, at least some of the top surface 36 of the first mesh 10 as an overhang. (Page 4, lines 19-21).

#### **F. Grounds of Rejection to be Reviewed on Appeal**

1. Whether the Examiner properly rejected claims 1-7, 9 and 10 as being anticipated by Nowell et al., U.S. Patent No. 4,885,659 (hereinafter “Nowell”) in the Final Office Action.
2. Whether the Examiner properly rejected claim 8 as being obvious over Nowell et al. in view of Sugahara et al., U.S. Patent No. 5,780,147 (hereinafter “Sugahara”) in the Final Office Action.

### **II. ARGUMENT**

#### **A. Anticipation Rejection of Claims 1-7, 9 and 10 based on Nowell**

##### **1. Rejection of Claims 1-7, 9 and 10**

Nowell shows a static dissipative mat. In this application, an electrically conductive, metallized glass fiber tissue material is disposed within a thermoplastic layer to provide a static dissipated service covering material. Nowell teaches placing a tissue type mat coated with aluminum into a thermoplastic polymer in a variety of manners in Column 4, line 65-Column 5, line 37. Although in Column 5 at lines 1-5, one method of creating the structure shown in Figure 3 is described as positioning a sheet material to penetrate a liquid plastisol or resin to a desired location before heating to gel the layer, there is no discussion or suggestion in the Nowell reference that a particular surface

texture is created as a result of this process. In fact, in Column 5, lines 37-38 the upper surface is described as being embossed **after** such a process. There is no teaching or suggestion in the Nowell reference that imbedding of the tissue in that structure creates a specific surface pattern as claimed.

Nevertheless, the Office Action dated December 15, 2006, relies on this newly-cited reference for the proposition that “embossing the surface” in Nowell after embedding the mesh is equated to the “applicant’s formed bubbles.” The applicant does not believe forms a proper *prima facie* case of obviousness much less a proper case of anticipation. The bubbles as claimed by the applicant are not described or suggested in the Nowell reference. It is only with the use of hindsight in the applicant’s disclosure that such a comparison could be formulated. Furthermore, by the Office Action equating the **subsequent step** of embossing as the bubbles, the Office Action admits that the product by process as claimed by the applicant is not performed by the cited reference.

Section 2131 of the MPEP requires that TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM. Specifically: “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegall Bros. v. Union Oil Co. of California, 814 F.2d. 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The bubble limitation cannot be met by Nowell since Nowell explicitly teaches away from providing such structure.

Merely changing the anticipation rejection to an obviousness rejection would also not be proper since MPEP § 2142 requires that when establishing a *prima facie* case of obviousness, the references must teach or suggest all the claim limitations. In re Vaeck,

947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991), MPEP § 2145 (See X. Arguing Improper Rationales for Combining References, D. References Teach Away from the Invention Render Prior Art Unsatisfactory for Intended Purpose) and MPEP § 2141.02, namely *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983) and *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Since Nowell teaches away from providing bubbles as claimed by the Applicant and explained above, claims 1 is believed to be allowable. Claim 9 stands or falls with claim 1. Since claims 1-7 and 9-10 depend directly or indirectly from claim 1, they are believed to be allowable on this basis as well.

## **2. Rejection of Claim 2**

Claim 2 depends from claim 1 and requires the additional element of providing a repeating pattern in a skeletal frame. The tissue in Nowell is consistently referred to as “tissue” and in Column 4, line 29 is described as “randomly-oriented pattern.” (emphasis added). The applicant would propose that random orientation and repeating patterns are mutually exclusive of one another and this claim is believed to be allowable in the separate ground of allowance on this separate point.

## **3. Rejection of Claims 3-5**

Claim 3 depends from claim 1 and requires the additional element of providing a top surface of the bubble which extends a distance above the top surface of the runners of a skeletal frame and completely fills openings between runners. In Nowell, the subsequent step of embossing has been equated to the applicant’s bubbles.

It is difficult for the applicant to utilize the logic of the Office Action to determine where a particular embossing might start and stop as the applicant is without a basis to compare the dissimilar structures. Embossing without using the applicant's disclosure would have no reference to evaluate where the runners might start or stop. Claim 3 appears to be separately allowable on this basis. Claim 4 depends from claim 3 and stand or falls with that claim. Claim 5 depends from claim 4 and can stand or fall with that claim for the purpose of this Appeal Brief.

#### **4. Rejection of Claim 6**

Claim 6 depends from claim 1 and includes the additional limitation of imbedding at multiple depths to create a design. Nowell appears to teach imbedding at a single depth in a manner not believed to create bubbles as discussed above for claim 1. There is not believed to be any disclosure in Nowell for imbedding a mesh at multiple depths. This is believed to be a separate basis for allowance for claim 6. This element was omitted from discussion in the Office Action and is believed to provide a separate basis for allowance of this claim.

#### **B. Obviousness Rejection of Claim 8 Based on Nowell in view of Sugahara, U.S.**

##### **Patent No. 5,780,147**

While Sugahara teaches a mesh can be a nylon material, it does not teach imbedding of a mesh providing bubbles as was effectively acknowledged by the Office Action with the withdrawal of the rejections based on Sugahara. This same teaching is also absent from the Nowell reference. Accordingly, the applicant remains confused as to how a combination of these two references teaches the claimed structure.



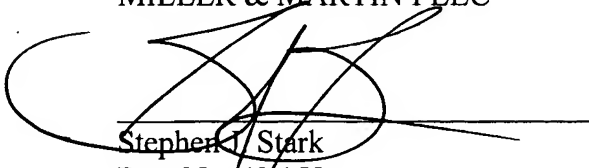
The Office Action continues to rely on a subsequent step in Nowell for embossing a surface as an equivalent of forming bubbles. The applicant respectfully and adamantly disagrees with this proposition as the product by process step provides for bubbles which are not produced by embossing. At least this one element is missing from the cited references.

### III. CONCLUSION

Claims 1-10 are not believed to be anticipated or obvious over Slosberg , US. Patent No. 4,689,258 which is believed to *expressly teach away from the claimed subject matter*. Allowance of claims 1-10 is respectfully requested.

Respectfully submitted,

MILLER & MARTIN PLLC



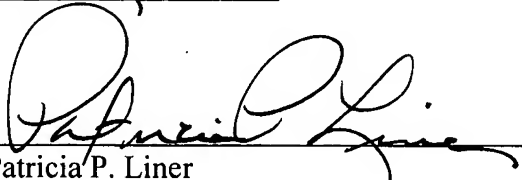
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On this 13<sup>th</sup> day of March, 2007.

  
Patricia P. Liner

## APPENDIX A

1. A flooring product comprising:  
a vinyl layer having a bottom layer portion and a top portion; and  
a skeletal frame having a pattern of runners disposed about openings, said runners having a height between a top surface and a bottom surface, said skeletal frame imbedded into the top layer portion of the vinyl sheet layer wherein bubbles are formed in the top portion of the vinyl sheet layer and have a top surface which extend a distance above the bottom surface of the skeletal frame and into the openings, and the bottom layer portion forms a non-porous sheet below the skeletal frame and top portion of the vinyl layer.
2. The flooring product of claim 1 wherein the pattern of the skeletal frame is a repeating pattern.
3. The flooring product of claim 1 wherein the top surface of the bubbles extend a distance above the top surface of the runners of the skeletal frame and completely fill the openings between the runners.
4. The flooring product of claim 3 wherein the bubbles overhang at least a portion of the top surface of the runners of the skeletal frame.
5. The flooring product of claim 4 wherein the bubbles

completely cover the top surface of the runners and have valleys extending above the top portion of the skeletal frame.

6. The flooring product of claim 1 wherein the skeletal frame is imbedded at several depths relative to the top portion of the vinyl layer to create a particular design.
7. The flooring product of claim 1 wherein the openings between the runners are substantially filled with the top portion of the vinyl layer.
8. The flooring product of claim 1 wherein the skeletal frame is a metal screen.
9. The flooring product of claim 1 wherein the skeletal frame is a nylon mesh.
10. The flowing product of claim 1 wherein the bubbles extend to fill the openings to a first depth throughout the openings.

## **APPENDIX B: EVIDENCE APPENDIX**

None

## **APPENDIX C: BOARD DECISION APPENDIX**

None